

REMARKS

Claims 1-30 are pending in this application. Claim 17 is cancelled herein.

Claims 1, 9, 18, 23, 29 and 30 are independent.

Claims 1-30 stand rejected under 35 USC §103(a) as obvious over Bedell, et al. (U.S. Patent No. 6,622,128). Claim 17 is cancelled, and accordingly the rejection is moot with respect to this claim. The rejection of claims 1-16 and 18-30 is hereby traversed.

It is first noted that the rejection is presented in an omnibus manner, without an element by element analysis. Accordingly, the basis for the rejection cannot reasonably be understood.

The Examiner seems to acknowledge that Bedell fails to disclose limitations recited in each of the independent claims, but takes Official Notice that each of the missing limitations is old and well known, and on this basis concludes that it would have been obvious at the time of the invention to modify Bedell to incorporate such missing limitations "for the advantage of leaving a record trail for auditing and verification of any missing or incorrect bill portion".

However, the Examiner has failed to clearly identify which of the claimed limitations are considered to be old and well known. Accordingly, the Official Notice cannot reasonably be understood.

Additionally, even if the missing limitations that the Examiner considers to be old and well known were clearly identified (which it is respectfully submitted is not the case), the Examiner has provided no rationale as to how one would go about modifying Bedell to incorporate the missing limitations.

Furthermore, while it is contended that modification of Bedell to incorporate the unidentified limitations is motivated “for the advantage of leaving a record trail for auditing and verification of any missing or incorrect bill portion”, no rationale is provided for the asserted conclusion.

Further still, it is entirely unclear why one would modify Bedell to obtain these advantages when, as understood, Bedell provides these advantages without modification.

Hence, the Official Notice is traversed and the Examiner is respectfully requested to either withdraw the rejection or to cite and properly apply prior art that establishes not only that the claimed limitations acknowledged to be missing from Bedell exist in the prior art, but also that the proposed modification of Bedell to incorporate the missing limitations is suggested and motivated within the applied prior art.

It is perhaps worthwhile to highlight that just because an element of a claimed combination exists in the prior art does not, in and of itself, make that element of the claimed combination obvious. Rather, the suggestion and motivation for modifying the applied art to incorporate the missing element, and thereby meet the limitations of the claimed combination of elements, must be found within the applied prior art itself.

As understood, the Examiner has recognized that Bedell lacks limitations recited in each of independent claims 1, 9, 18, 23, 29 and 30.

For example, independent claim 1 requires that a payer (1) receive (via a network) a bill having a charge and a location identifier (e.g., a hyperlink) of non-bill information upon which the charge is based (e.g., an insurance policy or tariff schedule,

etc.), (2) transmit (via the network) a request or the non-bill information, and (3) receive (via the network) the requested non-bill information responsive to the transmitted request.

As understood, the Examiner has acknowledged that Bedell lacks the required request for non-bill information and transmission of non-bill information responsive to the request, but considers it obvious (for reasons which are unclear) to modify Bedell to incorporate these missing limitations.

However, it is respectfully submitted that to modify Bedell to incorporate the required request for non-bill information and transmission of non-bill information responsive to such a request, as required by the present application claims, would be inconsistent with Bedell's own teachings.

The Examiner's attention is respectfully directed to Bedell's description of the payer's (i.e. the client's) access to the case summary information, which begins at column 42, line 35. As described therein, for example in column 46, on lines 44-46, the entire database having the case summary information is loaded onto the payer's (i.e. the client's) computer. Thus, according to Bedell's own teachings, the payer (i.e. the client) is provided with access to the case summary information without the need for the payer to request the case summary information via a network. Furthermore, since the payer has no need to request the case summary information via a network, there is necessarily also no need for the case summary information to be transmitted to the payer via the network responsive to such a request.

Therefore, it would appear that the Examiner's proposed modification of Bedell would be in violation of Bedell's own principles of operation.

It is perhaps worthwhile to note here that although, as understood, the Examiner is of the view that the case summary information includes "non-bill information", no particular information has been identified within the case summary information described by Bedell as corresponding to the required "non-bill information". Thus, it is also unclear what particular information, within the case summary information, the Examiner contends to be "non-bill information".

As discussed above, according to Bedell the database having the case summary information is downloaded onto the payer's (client's) computer, and the payer's (client's) only access to the available information is from the database stored at the payer's (client's) local computer. Thus, even if the case summary information were to include both a charge and "non-bill information" (which is not admitted), Bedell would require that this information be downloaded to and stored at the payer (client) computer.

As will be recognized, the conventional forwarding of hard copy bills to a payer by postal mail follows a push protocol. That is bills are typically mailed to the payer without a request from the payer for the bill. Furthermore, it is not uncommon for "non-bill information" on which a charge is based, to be mailed with the bill. For example, automobile and homeowner insurance policies are commonly mailed with the bill for the insurance premium.

If, for the sake of argument, one were to assume that Bedell's case summary information includes a bill having a charge as well as "non-bill information" on which the charge is based (once again, this is not admitted), Bedell would then teach downloading (pushing) the bill and the "non-bill information" on which the charge is based, onto the payer's (client's) computer. This, of course, corresponds to the conventional practice of

mailing a hard copy of a bill having a charge, together with the “non-bill information” on which the charge is based, to the payer (except that Bedell’s delivery is performed electronically via a network, rather than by postal mail).

As pointed out in the background of the present application, transmitting “non-bill information” to the payer with the bill, requires both sufficient bandwidth capacity to download the information to the payer’s computer and sufficient storage capacity to store the information at the payer’s computer, both of which have an associated cost. These requirements and costs have hindered the adoption of electronic presentment of bills (e.g. automotive insurance bills) which have charges based on “non-bill information” that the payer may wish to review prior to paying the bill.

Thus, even if Bedell’s case summary information included a bill having a charge and “non-bill information” on which the charge is based (which again is not admitted), Bedell would disclose a method of electronically delivering the bill and “non-bill information” which is not only relatively costly, but which also hinders the adoption of electronic presentment of bills which have been conventionally mailed to payers with “non-bill information” on which the billed charge is based.

The present invention is directed to overcoming these very problems (see page 5, line 18, through page 6, line 3) and to do so discloses an entirely new paradigm for the presentment of bills. More particularly, according to the present invention bills are presented without presentment of the “non-bill information” on which the billed charge is based. This is in stark contrast to both conventional hard copy mailings of bills with the “non-bill information” on which the charge is based, and to Bedell’s electronic delivery of all information in a single database download.

Thus, using the present invention, storage and bandwidth requirements and cost may be reduced and issues (present with Bedell) which have previously hindered the electronic presentment of bills having charges based, for example, on tariff schedules, insurance policies, or mortgage contracts etc. may be eliminated.

Hence, it is respectfully submitted that, at best, Bedell suggests nothing more than digitizing the hard copy delivery that was previously performed by the postal service. Bedell lacks any suggestion of the combination of claim 1. Indeed, Bedell fails to even recognize problems that the present invention is directed to solve.

It is respectfully submitted that the only disclosure that would have led one skilled in the art to the claimed combination is that which appears in the present application, and there is nothing which the Examiner has identified within the prior art to suggest otherwise.

Independent claims 9, 18, 23, 29 and 30 are also distinguishable for reasons which are believed to be clear from the above.

It is further respectfully submitted that other features recited in the dependent claims further and independently distinguish over the applied prior art.

For example, claim 3 requires that the non-bill information be a portion of a document, and that that document be a contract, tariff or warranty.

The Examiner points to Bedell's disclosure in column 42, lines 9-34, as suggesting locators for portions of documents as required by claim 3.

However, contrary to the Examiner's assertion, Bedell lacks any disclosure relating to a contract, tariff or warranty, let alone a document that memorializes a contract, tariff or warranty.

The text relied upon by the Examiner in support of the rejection relates to the billing system input interface, which allows certain advanced expenses to be billed by the firm (biller/payee) to the client (payer) for a given product prior to that product being completed. Thus what is being described is what the system software facilitates in terms of the firm's (biller's) input, and there is nothing whatsoever in the relied upon disclosure or elsewhere in Bedell to suggest that the billing system software (or the information stored in the related database) represents a contract, tariff or warranty document.

In rejecting claim 4, the Examiner appears to be pointing for support to Figures 3, 5-7 and 21.

However, as discussed above, what Bedell discloses is that the database is stored locally on the client's (payer's) computer. Therefore, Bedell has no need for, and the referenced figures lack any disclosure of hyperlinks, let alone hyperlinks configured as required by claim 4.

Claim 5 requires that the bill, including the charge and location identifier for the non-bill information, be transmitted to the payer by a bill presentment server, and that non-bill information be transmitted to the payer by other than a bill presentment server.

The Examiner points to column 12, lines 30-61, of Bedell as disclosing such features.

However, the referenced text discloses nothing of the sort. Rather, as discussed above in detail, in Bedell all information is transmitted to the payer (i.e. the client) by the biller (i.e., the firm).

Claim 6 requires that the bill presentment server be associated with a bill

presentment service provider and that the non-bill presentment server be associated with the biller.

The Examiner again relies on Bedell's disclosure in column 12, lines 30-61, as disclosing these limitations.

However, as noted immediately above, the reference section of the Bedell explicitly discloses that the firm (i.e., the biller) transmits all information (i.e., the full database) to the client (i.e., the payer).

Claim 8 requires that the bill also include a location identifier for non-bill information other than that upon which a charge is based.

For example, as described in the specification, if the bill is for a mortgage payment, the bill could include a location identifier to a portion of the mortgage contract that describes how the mortgage payment is computed (non-bill information upon which the charge is based), and another location identifier for a property title document (i.e., non-bill information which is not non-bill information upon which the charge is based).

The Examiner points to Figure 29 as somehow disclosing the limitations of claim 8.

However, it is entirely unclear what in Figure 29 the Examiner contends to be the required non-bill information location identifier, or even why Bedell, et al. might include a location identifier for such information in Figure 29 or more generally in the system software or database.

Other features recited in various other dependent claims also independently distinguish over the applied prior art for reasons which are believed to be clear from the above.

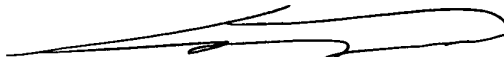
Accordingly, it is respectfully requested that the rejection of claims 1-16 and 18-30 be reconsidered and withdrawn.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Case No. 1158.41333X00) and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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